THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 52

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte SURENDRA H. AGARWAL

_____

Appeal No. 1995-2036
Application 07/920,009

_____

ON BRIEF

_____

Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 3, 4, 9 through 11, 16, 17, and 21 through 29, which are all of the claims remaining in the application.

Claims 23 and 26, which are illustrative of the subject matter on appeal, read as follows:

23. An improved low-modulus, flexible thermoplastic molding and extrusion composition having a flexural modulus of about 140,000 or below as determined in accordance with ASTM D790, comprising;

(a) about 20% by weight of a polyalkylene terephthalate resin;

(b) about 15% by weight of an aromatic polycarbonate resin;

(c) about 60% by weight of a substantially amorphous copolymer resin comprising a butadiene based core-shelled multiphased composite interpolymer resin;

(d) about 5% by weight of a mold release agent or a stabilizer.

26. An improved low-modulus, flexible thermoplastic molding and extrusion composition consisting essentially of:

(a) a substantially crystalline linear thermoplastic polyester resin composition;

(b) an amount of a component capable of reducing the flexural modulus of (a) to not substantially greater than about 140,000 psi, said component comprising a substantially amorphous copolymer resin.

The references relied on by the examiner are:

| | | |
|---|---|---|
| Pletcher et al. (Pletcher) | 4,066,600 | Jan. 3, 1978 |
| Fromuth et al. (Fromuth) | 4,180,494 | Dec. 25, 1979 |

The appealed claims stand rejected as follows:

(1) Claims 26 through 29 under 35 U.S.C. § § 102/103 as anticipated by or, in the alternative, unpatentable over Fromuth; and

(2) Claims 3, 4, 9 through 11, 16, 17 and 21 through 25 under 35 U.S.C. § 103 as unpatentable over Fromuth, considered alone or in combination with Pletcher.

## DELIBERATIONS

Our deliberations in this matter have included evaluation and review of the following materials: the instant specification and all of the claims on appeal; the Appeal Brief; the Examiner's Answer; the Gallucci Declaration executed December 12, 1991; the above-cited prior art references; and the decision entered by another merits panel of the Board in parent application serial no. 06/532,279, Paper No. 13 (Appeal No. 648-99, mailed August 27, 1986.) On consideration of the record, including those materials, we affirm the examiner's decision rejecting claims 26 through 29. However, we reverse the examiner's decision rejecting claims 3, 4, 9 through 11, 16, 17, and
21 through 25.

## CLAIMS 26 THROUGH 29

Fromuth discloses a thermoplastic composition comprising about 25 to 95 percent by weight of aromatic polyester (A), about 1 to 8 percent by weight of aromatic polycarbonate (B), and the balance to make 100% of core-shell polymer (C)(column 2, lines 54 through 58). Polyester component (A) is, for example, polyethylene terephthalate or polytetramethylene terephthalate (column 1, lines 60-64); aromatic polycarbonate (B) is

described in column 2, lines 1-14; and component (C) may be a butadiene-based core-shell polymer, preferably a three-stage polymer having a butadiene-based rubbery core, a second stage polymerized from styrene, and a final stage, or shell, polymerized from methyl methylacrylate and 1,3-butylene glycol dimethylacrylate (column 2, lines 47-53.)

Claims 26 through 29 “read on” a thermoplastic composition which includes three components, namely, an aromatic polyester resin, an aromatic polycarbonate resin, and a substantially amorphous copolymer resin. The substantially amorphous copolymer resin may be, for example, a butadiene-based core-shell interpolymer of the type “more fully described” in Fromuth. See appellants' specification, page 22, lines 18 through 24. We think it quite clear, and in fact undisputed, that claims 26 through 29 “read on” the same aromatic polyester resin, aromatic polycarbonate resin, and butadiene-based core-shell interpolymer described by Fromuth.

Considering now the relative proportions of components in the prior art polymeric blend, we find that Fromuth discloses as little as 25 percent by weight of aromatic polyester (A). Fromuth also discloses a relatively low amount of aromatic polycarbonate (B) in the blend, i.e., about 1 to 8 percent by weight. Accordingly, for those prior art compositions containing 25 percent by weight of aromatic polyester and about 1 to 8 percent by weight of aromatic polycarbonate, the balance is about 67 to 74 percent by weight of core-shell polymer (C). On these facts, where Fromuth discloses thermoplastic

polyesters containing a relatively high proportion of core-shell polymer (about 67 to 74 percent by weight), we find that the claimed and prior art thermoplastic compositions reasonably appear to be identical or substantially identical. A person having ordinary skill in the art would have appreciated that the prior art compositions containing a relatively high proportion of core-shell polymer also possess a relatively high degree of flexibility of low flexural modulus.

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on "inherency" under 35 U.S.C. § 102, on "prima facie obviousness" under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34, (CCPA 1977). This appellant has not done. We have carefully reviewed the evidence of record, including the Gallucci Declaration executed December 12, 1991. Appellant has not established, however, that the Fromuth thermoplastic polyesters containing a relatively high proportion of core-shell polymer (about 67 to 74 percent by weight) do not have a flexural modulus having the upper limit recited in claims 26 through 29. Appellant has not established that the closest

prior art compositions disclosed by Fromuth "do not necessarily or inherently possess the characteristics of his claimed product."

The rejection of claims 26 through 29 under 35 U.S.C. §§ 102/103 as anticipated by or, in the alternative, unpatentable over Fromuth, is affirmed.

CLAIMS 3, 4, 9 THROUGH 11, 16, 17, AND 21 THROUGH 25

Claims 3, 4, 9 through 11, 16, 17, and 21 through 25, however, stand on different footing. These claims require a relatively high amount of aromatic polycarbonate resin in the polymeric blend. For example, see illustrative claim 23, reproduced above, which recites "about 15 % by weight of an aromatic polycarbonate resin." As previously discussed, the invention disclosed by Fromuth is a thermoplastic composition containing about 1 to 8 percent by weight of aromatic polycarbonate. In our judgment, Fromuth's thermoplastic compositions containing about 1 to 8 percent by weight of aromatic polycarbonate would not have suggested the compositions recited in claims 3, 4, 9 through 11, 16, 17, and 21 through 25 which require at least about 15 parts by weight or about 15 percent by weight of an aromatic polycarbonate resin. The examiner has not established that a person having ordinary skill in the art would have been led from "here to there," i.e., from the thermoplastic polyester compositions of Fromuth containing a relatively low amount of aromatic polycarbonate (about 1 to 8 percent by weight) to the thermoplastic compositions in claims 3, 4, 9 through 11, 16, 17, and 21 through 25 containing a relatively

high amount of aromatic polycarbonate (at least about 15 parts by weight or about 15 percent by weight).

The examiner argues that (1) Fromuth, in column 1, lines 12 through 23, discusses Nakamura, U.S. Patent No. 3,864,428, and (2) according to Fromuth, Nakamura discloses a relatively high amount of aromatic polycarbonate in its polymeric blends. The examiner, however, does not cite or rely on the Nakamura patent in setting forth a prior art rejection before us. The examiner relies on Fromuth's discussion or characterization of Nakamura, but Fromuth does not indicate the relative amounts of aromatic polyester or butadiene-based core-shell polymer in the polymeric blends disclosed by Nakamura. On these facts, we find that Fromuth's discussion of Nakamura constitutes insufficient evidence to support a conclusion of obviousness or claims 3, 4, 9 through 11, 16, 17, and 21 through 25 which enumerate the relative amounts of each component in the claimed thermoplastic composition.

The examiner also argues that several comparative examples disclosed by Fromuth include a relatively high amount of aromatic polycarbonate, for example, 15 percent by weight, which meets the amount of aromatic polycarbonate resin recited in claims 3, 4, 9 through 11, 16, 17, and 21 through 25. The examiner has not established, however, that any comparative example described by Fromuth would have led to a thermoplastic composition defined in claims 3, 4, 9 through 11, 16, 17, and

21 through 25 which enumerate the relative amounts of each component in the claimed thermoplastic composition. It is not enough that comparative examples in Fromuth include a sufficient amount of polycarbonate resin to meet one of the limitations in appellant's claims. The examiner has not established that claims 3, 4, 9 through 11, 16, 17, and 21 through 25 considered as a whole, including each polymeric component and the amount of each polymeric component, would have been suggested by any of the comparative examples disclosed by Fromuth.

The Pletcher patent is relied on to show that triphenylphosphate is a known plasticizer for crystallizable linear polyesters. See Pletcher, particularly column 5, lines 1 through 12. Pletcher, however, does not cure the deficiencies of Fromuth with respect to the patentability of claims 3, 4, 9 through 11, 16, 17, and 21 through 25.

The rejection of claims 3, 4, 9 through 11, 16, 17, and 21 through 25 under 35 U.S.C. § 103 as unpatentable over Fromuth, considered alone or in combination with Pletcher, is reversed.

## CONCLUSION

In conclusion the rejection of claims 26 through 29 under 35 U.S.C. §§ 102/103 as anticipated by or, in the alternative, unpatentable over Fromuth, is affirmed. The rejection of claims 3, 4, 9 through 11, 16, 17 and 21 through 25 under 35 U.S.C. § 103 as

unpatentable over Fromuth, considered alone or in combination with Pletcher, is reversed. Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

| | |
|---|---|
| SHERMAN D. WINTERS<br>Administrative Patent Judge | )<br>)<br>)<br>)<br>) BOARD OF PATENT |
| WILLIAM F. SMITH<br>Administrative Patent Judge | )<br>) APPEALS AND<br>)<br>) INTERFERENCES |
| HUBERT C. LORIN<br>Administrative Patent Judge | )<br>) |

SDW/cam

Mary A. Montebello
GE Plastics
One Plastics Avenue
Pittsburgh, MA 01201